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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

B-4258CIP 619319-4

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on November 10, 2005

Signature

Typed or printed
name

Alma Smalling

Application Number

09/997,199

Filed

November 28, 2001

First Named Inventor

James A. DAVIS

Art Unit

2642

Examiner

Guy J. LAMARRE

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐

attorney or agent of record.

Registration number _____

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 43,010

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November 10, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒*Total of 3 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Rejection under 35 U.S.C §102

Claims 4-19 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,458,349 to Aichelmann. In the Final Action, the Examiner tersely states that Appellant's previous arguments are not found persuasive "for it is unclear to the Examiner what is meant by '37 CFR 102, 103' in passim in the Applicants' remarks." Appellant acknowledges the obvious typographical error, but is in utter disbelief that this would present a problem to a Primary Examiner in realizing that what Appellant intended to refer to is 35 U.S.C. §102 and §103 – after all, Appellant's remarks were presented under the clear (and correct) heading of Rejection under 35 U.S.C §102. The Examiner's utterly non-responsive and flagrantly off-handed dismissal of Appellant's detailed discussion of the prior art and clear explanation of the patentable merits of the instant invention is thoroughly unprofessional, completely in violation of the clear requirements enunciated in the Code of Federal Regulations and expounded upon in the MPEP, a significant and unwarranted waste of Appellant's financial resources as well as the period of protection afforded by any patent that may issue of this application (not to mention the expense borne by the PTO for the present Appeal), and borders on the insulting.

If, on the other hand, the Examiner has realized that Appellant made a typographical error and is merely confessing that he is not familiar with the Federal Regulations that he is to apply as part of his job, Appellant finds this to be a disturbing, to say the least, but not surprising development in view of the utterly baseless and illogical rejections repeatedly levied by the Examiner in this case.

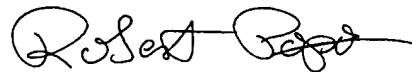
In the non-final Office Action mailed on December 21, 2004, which is the last Action in which the Examiner made an attempt at actually explaining himself, claim 6 stood rejected despite the fact that a claimed limitation is clearly not in Aichelmann because the Examiner found that this limitation is "well within *the scope of* Aichelmann's invention since a person of ordinary skill in the art *understands* that a threshold value, in this situation, can be either a fixed value or a range or ranges of values." Appellant very clearly and patiently explained to the Examiner (please see Appellant's April 18, 2005 Response, last paragraph on page 4) that this is an improper

rejection under §102 because to support a proper §102 rejection, a prior art document must teach each and every limitation of the rejected claim. Because the Examiner himself clearly acknowledged that Aichelmann does not teach at least the limitation of comparing each parametric value against a range or ranges, Aichelmann clearly could not support a §102 rejection. In the final Action, the Examiner apparently (and blithely) thinks he overcomes Appellant's argument by either (1) professing an ignorance of the law or (2) attempting to engage in semantic games.

The Examiner's almost incredible lack of "clarity" regarding '37 C.F.R. 102, 103' notwithstanding, the Final Action makes no attempt at even mentioning claims 4 and 5, the patentability of which was addressed in great length in the previous response (please see page 3 and the first half of page 4) and with no connection at all to the unfortunate '37 C.F.R. 102, 103' typo. Thus, regardless of what the Examiner's professed 'lack of clarity' really means, Appellant is left totally in the dark regarding the Examiner's current view of the patentability of claims 4 and 5.

For all of the above reasons, Appellant respectfully submits that the Final Office Action mailed on July 14, 2005 contains multiple clear errors in the Examiner's rejections and that the Examiner's rejections omit essential elements required for a prima facie rejection. Appellant thus respectfully requests that the application be allowed on the existing claims and prosecution remain closed.

Respectfully submitted,



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